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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/415,294   | 02/25/2004  | James F Stewart      | PAT 537W-2          | 5585             |
| 26123  | 7590        | 09/22/2004           | EXAMINER            |                  |
| BORDEN LADNER GERVAIS LLP<br>WORLD EXCHANGE PLAZA<br>100 QUEEN STREET SUITE 1100<br>OTTAWA, ON K1P 1J9<br>CANADA |             |                      | CLARDY, S           |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1616                |                  |

RECEIVED

SEP 28 2004

Borden Ladner Gervais LLP / S.11

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PAI 537W-2 OA (Dec 22/04) Sum/DLC  
PAT 537-0 -um/MBB  
PAT 537A-2 IDS (Dec 22/04) Sum/DLC  
PAT 537-1 -4 Serial 2004-5 (Dec 21/04) A-C/S.M.C

**Office Action Summary**

Application No.

10/415,294

Applicant(s)

STEWART ET AL.

Examiner

S. Mark Clardy

Art Unit

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —  
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

(12-22-04)  
 ENTERED SEP 28 2004

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.  
 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 30-46 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 30, 44 and 46 is/are rejected.  
 7) ☒ Claim(s) 31-43 and 45 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☒ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 4/28/03  
 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) ☐ Notice of Informal Patent Application (PTO-152)  
 6) ☐ Other \_\_\_\_\_

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Claims 30-46 are pending in this application which has been filed under 35 USC 371 as the national stage of international application PCT/CA01/01508, filed October 26, 2001. The priority data has not been entered as the first line of the specification.

Applicants' claims are drawn to compositions comprising 2N-octanol and oley-cetyl alcohol<sup>1</sup>, in combination with at least one of:

- Fatty alcohol alkoxylate
- Polyoxyethylene (2) oleylether
- Aromatic hydrocarbon distillate
- Methylated seed oil
- Polyoxyethylene (8) nonylphenolethin
- Sodium lauryl sulfate
- N-nutrient (diammonium phosphate or sulfate, ammonia, ammonium nitrate)
- Tetrasodium EDTA
- Colloidal silica
- A terpene
- Polyethoxylated amine
- Polyoxyalkylated alcohol
- C18 free fatty acid blend
- N-butanol
- Methanol
- water

Applicants are requested to clarify the meaning of the term "phenolethin".

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 46 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. "Use" claims are non-statutory in US practice.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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<sup>1</sup>Taken to be a mixture of oleyl alcohol (octadecen-1-ol) and cetyl alcohol (hexadecanol).

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 30 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of and Lover et al (US 4,368,207) and Tomlinson et al (US 5,783,202).

Lover et al teach that alcohols are effective as pediculicidal and/or ovicidal agents. In Tables I and II (columns 3 and 4), n-butanol and other butanol isomers exhibit pediculicidal activity, as do higher alcohols such as n-octanol, hexadecyl alcohol, and oleyl alcohol. The mite controlling compositions comprise at least one alcohol selected from the group consisting of octanol, decanol, dodecanol, and hexadecyl alcohol (claim 4).

Tomlinson et al teaches pyrethrin pediculicidal compositions comprising a quick breaking alcoholic foaming agent comprising an aliphatic alcohol, a fatty alcohol, water, and a surface active agent (claim 12) wherein the aliphatic alcohol component is selected from methanol, ethanol, isopropanol, butanol, or propylene glycol; the fatty alcohol component is selected from cetyl, stearyl, lauryl, myristyl, or palmityl alcohols; and the surfactant is selected from sorbitan EO esters, oleatews, nonyl phenol ethoxylates, fatty alcohol ethoxylates, and quaternary ammonium phosphate salts (claim 21). While no single example discloses the combination of octanol, cetyl/oleyl alcohol(s), and at least one of the claimed components above such as methanol, butanol, or alkoxyated alcohols or ethers, the claims are sufficiently limited in scope to enable the skilled artisan to select methanol or butanol from the list of five aliphatic alcohol components, and cetyl alcohol from the list of five fatty alcohol components in order to make the quick breaking alcoholic foaming agent of claim 12.

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One of ordinary skill in the art would be motivated to combine these references because they disclose pediculicidal agents which may be used in combination.

Thus, it would have been *prima facie* obvious to one of ordinary skill in the art of pediculicidal compositions to combine components such as octanol, oleyl (octadecenyl) alcohol, and cetyl (hexadecyl) alcohol, in a single aqueous composition because they have been disclosed as being useful in combination for pediculicidal compositions, further in combination with water and lower alcohols such as methanol and butanol. While this rejection is based on non-analogous (i.e., non-agrochemical) art, the rejected claims are drawn to a composition, the components of which have been disclosed as being useful in combination for another purpose. Therefore, their combination is obvious, albeit for a different reason than the utility disclosed herein.

No single reference, or combination of references, has been found which discloses the specific combinations in claims 31-43 and 45.

Claims 31-43 and 45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

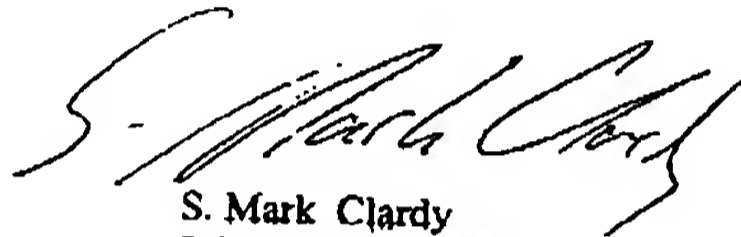
Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is 571-272-0611. The examiner can normally be reached on 7:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Mark Clardy  
Primary Examiner  
Art Unit 1616

September 20, 2004